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In re Application of :
HUNT, Simon :
U.S. Application No. 09/762,852 :
PCT No.: PCT/GB99/02665 :
Int. Filing Date: 12 August 1999 :
Priority Date: 14 August 1998 :
Attorney Docket No.: 0234/00070 :
For: INTERACTIVE SYSTEM FOR ENABLING :
TV SHOPPING :

DECISION ON PETITION
UNDER 37 CFR 1.47(b)

This is a decision on applicant's "Petition under 37 C.F.R. 1.47(b)" filed 12 July 2001 to accept the application without the signature of the sole inventor, Simon Hunt. The petition fee of \$130 has been submitted.

BACKGROUND

On 12 August 1999, applicant filed international application no. PCT/GB99/02665 which claimed a priority date of 14 August 1998. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 24 February 2000. A proper Demand was filed with the International Preliminary Examination prior to the 19th month from the earliest claimed priority date. Accordingly, the thirty-month time period for submitting the requisite basic national fee in the United States of America was extended to expire 30 months from the international filing date, i.e., 14 February 2001.

On 14 February 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which was accompanied by the requisite basic national fee as required by 35 U.S.C. 371(c)(1); a copy of the international application; and a preliminary amendment.

On 12 March 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed. The notification set a one-month time limit in which to respond.

On 12 July 2001, applicant filed "Petition under 37 C.F.R. 1.47(b)" and a three-month extension.

DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the requisite petition fee under 37 CFR 1.17(i); (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the nonsigning inventor; (4) an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning

inventor; (5) proof of proprietary interest in the application; and, (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damages. The 37 CFR 1.47(b) applicant has satisfied the requirements of items (1), (3), (5) and (6) above. However, items (2) and (4) and have not been satisfied.

Regarding Item (2), section 409.03(d) of the Manual of Patent Examining Procedure (M.P.E.P.), **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of its refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

A review of the present petition and papers reveal that petitioner has not provided sufficient proof that the non-signing inventor refuses to execute the application. As stated in Mr. Hunt's 09 February 2001 letter, "I formally confirm that immediately on receipt of your letter I telephoned my solicitor Kingsford Stacey Blackwell who subsequently made contact with Paul Lambdin of Stevens & Bolton to request authority from Nisaba Group Ltd. to proceed . . . Nisaba Group has failed to respond . . ." Mr. Hunt's letter does not indicate a refusal to sign the application papers, but rather a willingness to sign the papers pending clarification of certain issues. Has counsel's client, Media Logic Systems (Nisaba Group Ltd.), received inquires from Mr. Hunt or his solicitor regarding the patent papers?

Regarding Item (4), an oath or declaration executed by the 37 CFR 1.47(b) applicant on behalf of and as agent for the nonsigning inventor has not been provided. Petitioner states, "[e]nclosed is a declaration signed by the Managing Director of the Assignee of the application." However, a review of the petition and application file reveal that the declaration is not located therein.

For the reasons stated above, it would not be appropriate to accept the application without the signature of Simon Hunt under 37 CFR 1.47(b) at this time.

CONCLUSION

The petition filed under 37 CFR 1.47(b) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO MONTHS** from the mailing date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b).

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Legal Affairs Division of the PCT Legal Office.

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